

REMARKS

In response to the Office Action mailed April 21, 2004, Applicants amend their application and request reconsideration. No claims are added or cancelled so that claims 17-22 remain pending.

All claims were rejected as both indefinite and as not directed to statutory subject matter based upon *Ex parte Lyell*, 17 USPQ2d 1548 (Board of Appeals 1990). That decision is inapplicable to the claim 17 that was examined because the form of the claim presented in *Lyell* was substantially different from the form of the claim 17 that was examined. Nevertheless, in order to advance the prosecution without dwelling upon these rejections, claim 17 has been amended as to form. The content of claim 17 remains unchanged in the foregoing Amendment. The environmental elements formerly described in the preamble of the claim are now referred to throughout the claim. Just as examined claim 17 was unarguably a method claim, amended claim 17 is clearly a method claim and therefore directed to statutory subject matter.

Claims 17-19 were rejected as unpatentable over Pauly et al. (U.S. Patent 4,958,280, hereinafter Pauly) in view of Fay (U.S. Patent 5,983,201) and further in view of Eberhardt (U.S. Patent 5,659,741).

As a first matter, if the Examiner intends to rely upon Eberhardt, that patent needs to be made of record in this patent application. No copy of that patent was supplied with the Office Action and the patent is not listed on any PTO-892 Form that has been issued in the prosecution of this patent application. Therefore, that patent needs to be cited on a PTO-892 Form and made of record in the prosecution of this patent application. Assuming that step will be taken, the rejection is respectfully traversed.

The invention as described in amended claim 17 provides a number of steps, including transferring various information concerning a contact lens customer from a prescriber, for example, an ophthalmologist, who uses an information processing apparatus that is part of a group of such apparatus connected through a network to a number of different such prescribers. The information is transferred amongst the network to which respective contact lens sellers may be connected. A single contact lens seller is focused on in claim 1. That seller has an information processing apparatus connected to the network. In the claimed method, among other steps, there is issued to each contact lens customer a portable recording medium containing information relating to the contact lenses that are prescribed and to contact lenses that are subsequently issued.

An important feature of the invention is that, using this portable recording medium, a customer can change prescribers while maintaining contact with a particular lens seller. In rejecting the claims, the Examiner asserted that this feature was not described in the examined claim. Without discussing that contention, it is clear that the Examiner's position as to this feature of the invention is not tenable with respect to amended claim 17.

Further, an important feature of the invention, not described in any reference applied, is that the information is used, through the network interconnecting the first and second group information processing apparatus to notify the customer of a deadline for exchanging contact lenses, based upon the particular kind of lenses prescribed and dispensed, e.g., the expected life of the lenses. Further, the claimed invention as defined by amended claim 17 involves delivering contact lenses from a selling agent to a customer, the selling agent being identified by the contact lens seller participating in the system as the agent who is nearest the location of a particular contact lens customer.

Pauly is different from the invention in an important way not referred to by the Examiner. An important feature of Pauly is an avoidance of disruption of patient-physician relationship. See Pauly at column 2, lines 15-22. An object of the invention is directly opposite that objective. By supply the portable recording medium, the contact lens customer can change prescribers easily, while maintaining a relationship with a nearby contact lens dispenser, i.e., seller.

With regard to Fay, Applicants agree that Fay does not describe the dispensing of contact lenses, as acknowledged in the Office Action at page 4. Rather, Fay concerns dispensing of eyeglass frames through the provision of a virtual optician. An important feature with regard to the sale of eyeglass frames having no relationship to the dispensing of prescription contact lenses, leaving aside the absence of any medical implications of selling eyeglass frames, is the appearance of the frames on the wear of eyeglasses. In Fay, an image of the face and head of the eyeglass wearer is captured so that the eyeglass wearer can view images of himself wearing different glasses, based upon computer images of eyeglass frames produced by a wide variety of manufacturers. In fact, the variety is far wider than would be available at a single optician.

According to the Office Action, the description in Fay at column 9, lines 4-8 provides a basis for applying the Fay system to the dispensing of contact lenses and thereby modifying Pauly. This assertion is erroneous. What is described at the cited passage is that the Fay system is suitable for selling of items other than eyeglass frames that are related to personal appearance and in which the customer would wish to view an

image of his appearance using the particular product. Examples provided are jewelry, cosmetics, and hair products. Since the use of contact lenses does not modify a person's appearance, there would be no reason to consult images with regard to different contact lenses to determine which lenses to select. Stated another way, there is no teaching whatsoever in Fay that would recommend it to one of skill in the art for modifying what is described in Pauly. For that fundamental reason, the rejection is erroneous and cannot be properly maintained.

Finally, reliance is newly placed on Eberhardt as describing a credit-card sized memory device upon which, according to Eberhardt's speculations, an entire medical history of an individual, including the prescription of drugs, can be stored. Assuming, for the sake of argument, that the medical history referred to by Eberhardt could include eye examinations and prescriptions of contact lenses, the addition of Eberhardt to the alleged combination of Pauly and Fay would still not provide all of the elements of claim 17 and could not establish *prima facie* obviousness of that claim.

As already noted, the modification of Pauly with Fay is factually erroneous, undermining the rejection. In addition, none of the three references cited provides any means of notifying a contact lens user of an impending date for exchange of contact lenses, based upon a prior dispensing date for the contact lenses and the characteristics of the lenses dispensed. Because of that difference alone, the rejection is erroneous and should be withdrawn.

Further, none of the three references describes a method in which a person obtaining a product, such as a contact lens, that requires prescription by a professional, can easily move from professional to professional while maintaining a consistent relationship with a dispenser of the product through the use of a portable recording medium. As noted, the comparable teaching appearing in Pauly is just the opposite because it is directed to preventing changing of or interfering with an established physician-patient relationship. There are no prescribed goods in the selling of eyeglass frames as in Fay. In fact, by providing the virtual optician, once the customer selects a particular desired eyeglass frame, that customer may have to find a particular optician who carries those frames. Even if that information is supplied via the computer, there is no assurance that the optical retailer chosen is the retailer closest to the customer. The passage at column 6, lines 35-54 of Fay, to which the Examiner directed attention, presumes that a customer would select the retailer supplying the particular frames desired. However, that assertion fails to acknowledge that, as pointed out by Fay, different retailers carry different brands of eyeglass frames so that the retailer selected is not the

retailer participating in the system who is nearest the customer, but the retailer participating in the system who carries the selected eyeglass frames and is closest to the customer. This difference further differentiates the invention defined by claim 17 from the asserted combination of publications.

Finally, the portable medical history record described by Eberhardt is only described with respect to physicians and like medical practitioners. While a user of the card might be able to move from physician to physician, amongst the physicians participating in the system, there is no description in Eberhardt of using the card to interact with sellers of goods, such as pharmacies, that could suggest the constancy of relationship with a dispenser of prescribed goods as in amended claim 17.

For all of the foregoing reasons, upon reconsideration, the rejection of claims 17-19 should be withdrawn.

Claims 20 and 21 were rejected as unpatentable over Pauly in view of Fay and further in view of an article by Steltzer previously cited. There are two fundamental errors in this rejection that require further explanation by the Examiner if the claims are not allowed. First, it is not apparent what disposition has been made with regard to dependent claim 22. Reference is made to claim 22 in the first line at page 8 of the Office Action. Therefore, it has been presumed that claims 20-22 were rejected on the same basis, rather than claims 20 and 21 only. Second, claims 20-22 are all dependent claims. Each of these claims depends directly or indirectly from claim 17, a claim that was rejected based upon an asserted combination of Paul, Fay, and Eberhardt. It is not apparent whether Eberhardt is included in the rejection of claims 20 and 21, or claims 20-22, since there is no reference to that patent in the second rejection. For the sake of advancing prosecution, it is assumed that claims 20-22 were rejected based upon the same grounds as the rejection of claims 17-19 and further in view of Steltzer. If the rejection is not withdrawn, Applicants respectfully request that the rejection be clearly and accurately stated. The presumed rejection of claims 20-22 is respectfully traversed.

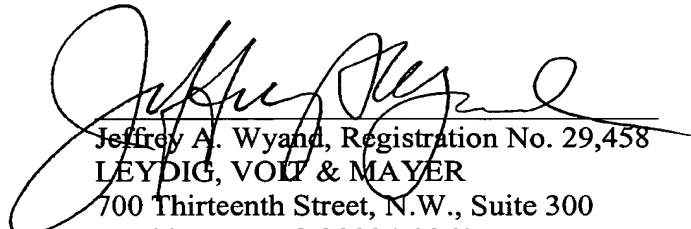
The rejection is respectfully traversed for a very fundamental reason. Even assuming, solely for the sake of argument, that Steltzer supplied the limitations of dependent claims 20-22, Steltzer still fails to describe the parts of amended claim 17 that are missing from the other three publications applied in rejecting that claim. According to Steltzer, the contact lens supplier only acts on physician prescription or customer ordering. There is no description of giving advance warning to contact lens users of the necessity of refilling prescriptions, i.e., exchange deadlines. Further, the Steltzer article describes an arrangement that, like Pauly, is devoted to maintaining a physician-client

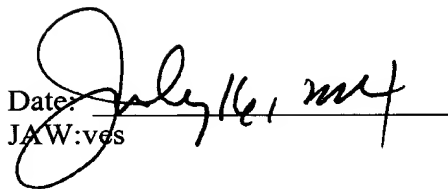
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relationship, clearly avoiding an important feature of the invention that allows the contact lens user to change prescribers easily, at will. Therefore, independent of the withdrawal of the rejection of claim 17, the rejection of claims 20-22 should be withdrawn.

Reconsideration and allowance of claims 17-22 are earnestly solicited.

Respectfully submitted,


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